

REMARKS

Claims 1-3, 10, 12, 16-23, 29 and 31 are pending. Claims 1-3, 10-12, 16-17 have been rejected. Claims 18-23, 29 and 31 have been withdrawn from consideration as directed to a non-elected invention.

Election/Restrictions

Applicants hereby confirm the election of Group 1, including claims 1-3, 10-12, 16 and 17. This election is made without traverse. Applicants have amended withdrawn independent method claim 18 to effectively recite the laminate material of claim 1 as a material employed in the method, and request that the method claims be rejoined, in accordance with *In re Ochai*, should the subject matter of claim 1 be found to be allowable.

Interview Summary

Applicants thank the Examiner for her courtesy and suggestions during the interview with the undersigned attorney on July 27, 2007. The Examiner's summary of the interview has yet to be received. The standing obviousness rejection of claim 1 was discussed broadly, and particularly the disclosures of the Shepard and Franz references were discussed. Applicants' positions with respect to patentability, as discussed in the interview, are repeated below. The Examiner was helpful in noting some of what she considered to be distinguishing aspects of Applicants' disclosed concepts, which are reflected in the above amendments. No agreement as to patentability was reached during the interview.

Claim Rejections – 35 USC §103

Claims 1-3, 10-12, 16 and 17 have been rejected under 35 U.S.C. §103(a) as being obvious over WO 99/11452 to Shepard et al. ("Shepard") in view of U.S. Pat. No. 5,224,895 to Franz ("Franz"). Applicants respectfully request reconsideration and withdrawal of this rejection, in light of the following remarks.

At the Examiner's suggestion, the preamble of claim 1 has been amended to more particularly recite the field of this invention, namely flexible building construction laminates. This field is considered to include flooring and roofing underlayments, as well as laminates employed in wall construction.

The Examiner is correct that Shepard (the same Shepard as named in this application) discloses a "sheet-form fastener component with hook-engageable loops defined by a knit or non-woven web material having a basis weight of less than about 4 ounces per square yard" as recited in claim 1. Indeed, the material that Shepard discloses is considered by Applicants to be a suitable material for use in the claimed invention. Applicants consider their invention to be in the particularly claimed combination of this material with paper in a flexible building construction laminate.

The Examiner attempts to reach Applicants' invention, starting with Shepard, by first noting that Shepard discloses the use of the lightweight loop material in a display system, and cites Franz as disclosing a display system incorporating loop fasteners and paper. Therefore, according to the Examiner, "it would have been obvious to one having ordinary skill in the art to choose a display system made from paper."

Applicants note that a proper obviousness analysis must involve a determination of the relevant knowledge of the skilled artisan. In the context of this invention, "the art" is the art of building construction and laminates constructed to be used for that purpose. Therefore, one of ordinary skill in "the art" would be generally aware of the general requirements and suitability of materials for use in the construction trades.

As a preliminary matter, Applicants submit that Franz is non-analogous art. Each cited reference must meet a two-step test to determine if it is analogous art and therefore properly asserted in an obviousness rejection. The first step is to determine whether the reference is "within the field of the inventor's endeavor".¹ If not, the reference may still be pertinent if it is "reasonably pertinent to the particular problem with which the inventor was involved."²

¹ In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

² Id.

The inventors define the field of endeavor, by their specification and claims.³ In this case, the claims in issue all incorporate the preamble of claim 1: "A flexible building construction laminate." The field of invention is not display systems, nor more broadly laminates or materials. Franz, directed to a "LEARNING ACTIVITY FOR SMALL CHILDREN," is clearly far removed from the field of Applicants' endeavor, and therefore fails to meet the first test.

Moreover, Franz also fails the second test, because it is not a prior art reference which, "because of the matter with which it deals, would have commended itself to an inventor's attention in considering his problem."⁴ It is improper to define the "problem" broadly, in hindsight, in order to legitimize an improper reference citation.⁵ A reference directed to a different purpose than the invention would have provided less motivation or occasion to an inventor to have considered it.⁶ Here, Franz does not address the problem of how to make such a lightweight loop suitable for use as a building construction laminate, nor addresses even the broader problem of stabilizing loop materials against deformation in their plane. Rather, Franz simply notes that the components of her learning aid are preferably "formed of a relatively durable plastic material, providing sufficient strength to prevent deformation," that "any suitable material (paper of any desired strength and/or stiffness, etc.) may be substituted" and provides "reinforcing members 22 incorporated with each of the facial components 12 through 20 ... to preclude the intentional deformation of those components" to prevent ingestion by a small child. Such reinforcing members, illustrated as straight ribs extending across various facial components, are said to be formed of a "relatively stiff plastic component."⁷ Thus, Franz is not a reference that would have commended itself to an inventor's attention in considering how to form a flexible building construction laminate.

³ In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

⁴ Id.

⁵ To illustrate an example of an improperly broad problem formulation, Applicants note that the Court in *In re Clay* held that "A person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground formation anomalies."

⁶ Id.

⁷ Franz, col. 4, lines 10-16 and lines 25-34.

Even if Franz were considered to be analogous art, at the time of the invention one of ordinary skill would not have been motivated by a reasonable consideration of Shepard and Franz to produce the claimed invention. Shepard's loop material is described to be of "very low stiffness"⁸ and thus useful for many products, many of which are discussed in that reference. As the Examiner has noted, these applications include trade show displays, as more fully discussed in Shepard's later U.S. Patent No. 7,160,600. There is nothing in the general mention of trade show displays that suggests that they exhibit the particular form of flexibility and stiffness recited in claim 1. With regard to stiffness prior to bonding to some final receiving surface (e.g., to a box flap⁹), Shepard mentions stiffening the loop material for use as a filter by adding a "stiffening agent applied to the web" and preferably "corrugating" the web "to enhance the rigidity of the filter."¹⁰ This is consistent with Applicants' position that the loop material as disclosed by Shepard is of such a high flexibility that it is unsuitable for use as a building construction material requiring in-plane stability, such as for securing flooring or roofing materials, and that one reading Shepard concerned about such lack of stability would have noted that Shepard's own suggestions for stiffening the material (for use as a non-fastening filter web) would not have provided the necessary out-of-plane flexibility (due to corrugation) nor, perhaps, even the necessary fastening performance.¹¹

Such an ordinarily skilled artisan, turning to Franz for help with his problem, would not have found any disclosure leading or pointing toward the claimed invention. Rather, Franz' concerns with stiffness are primarily directed to making her smaller pieces stiffer to avoid ingestion, and such stiffness is supplied either by making the substrate itself of a durable plastic, or by adding reinforcing members that clearly increase the out-of-plane stiffness of the components, so as to preclude a child folding and then ingesting them.¹²

⁸ Shepard, col. 10, lines 54-56.

⁹ Id., col. 11, lines 31-40.

¹⁰ Id., col. 12, lines 19-28.

¹¹ It is not clear from Shepard's discussion of the filter in column 12 that after application of the stiffening agent the loops would have remained engageable. Hook engageability is not a necessary characteristic of filter materials.

¹² Franz mentions (col. 4, lines 16-21) that her various components may be stored in an organizer "in the form of one or more sheets which may be folded or rolled for more compact storage" but this does not mean that the

Even if one of ordinary skill in this art would have been motivated to combine Shepard and Franz, the result would not have been the invention as claimed. Simply put, the combination of these two references does not produce the invention, nor a *prima facie* case of obviousness, because the combination fails to provide all of the limitations recited in claim 1. Beyond neither reference disclosing or discussing any form of flexible building construction laminate, neither Shepard nor Franz disclose nor suggest providing a fastening laminate in which the non-loop substrate significantly stiffens the loop material against stretching in a plane of the laminate while remaining sufficiently flexible to be rolled up for storage and transport. There is nothing in either reference to suggest that such a product could be reasonably formed by *adhesively laminating* loop material to an appropriate paper substrate, thereby providing both the necessary in-plane stiffness and out-of-plane flexibility, while maintaining hook-engageable loops exposed for use as a fastener. Franz, it is noted, does not discuss the formation of an adhesive laminate with fastening loops, but rather suggests that the "hook and loop material 30 and 32 may be securely sewn into place upon the respective components 12, 18 and 20 in order to prevent removal by small children."¹³ Thus, Franz helps little in the consideration of forming adhesive laminates.

Applicants submit that all non-withdrawn dependent claims are allowable at least as depending from a non-obvious independent claim. However, Applicants also add the following remarks in an effort to be fully responsive to all of the Examiner's argument.

With regard to the Examiner's statements regarding the denier and areal stretch recited in the dependent claims, Applicants note for the record that Shepard does disclose areal stretch of greater than 50 percent, and does discuss fiber denier (giving examples of 6 and 15 denier). Applicants do not concur that the particular areal stretch and denier recited in the claims amounts to mere optimum values of result-effective variables. Indeed, no evidence has been presented that even identifies the result for which the Examiner believes these variables are known to be effective, to give Applicants an opportunity to rebut the Examiner's analysis in this regard.

components themselves are intended to be able to be folded or rolled up. Indeed, making the components flexible enough to be folded or rolled would be inconsistent with Franz' stated concerns regarding stiffness to preclude ingestion.

¹³ Franz, col. 5, lines 60-64.

With regard to claim 16, Applicants contend that, while it might be known to supply construction materials in roll form, the recitation of the material in roll form in this dependent claim further accentuates the flexibility characteristic recited in claim 1, and that claim 16 is allowable at least as depending from an allowable base claim. Furthermore, claim 16 recites a limitation not inherent to, nor inconsistent with, claim 1 and is therefore a proper subclaim.

With regard to claim 17, Applicants respond to the Examiner's invitation to point out that, to the extent Franz can be characterized as teaching a display system, Franz does not teach a laminate in which paper "has an exposed surface suitable for printing or writing thereupon" as recited in claim 17. The Examiner's broader characterization of Franz as having "at least one side ... exposed for the purpose of displaying an image" is not the limitation recited in claim 17. Nor is the recited characteristic inherent in any of the structures disclosed by Franz. For example, it is not clear from Franz' descriptions what surfaces, if any, are formed by the "any suitable material (paper ...)" of which Franz says that her components may be fashioned. It could equally well be argued that Franz' intended use of her components (as a learning system for small children) would suggest that the exposed surfaces be particularly immune from marking. In any case, as neither reference discloses the feature recited in claim 17, no *prima facie* case of obviousness has been made, and claim 17 is allowable, both in its own right and as depending from an allowable base claim.

Should the Examiner feel that further amendment or discussion may be necessary to place the claims in condition for allowance, she is welcomed to call the undersigned attorney at her convenience.

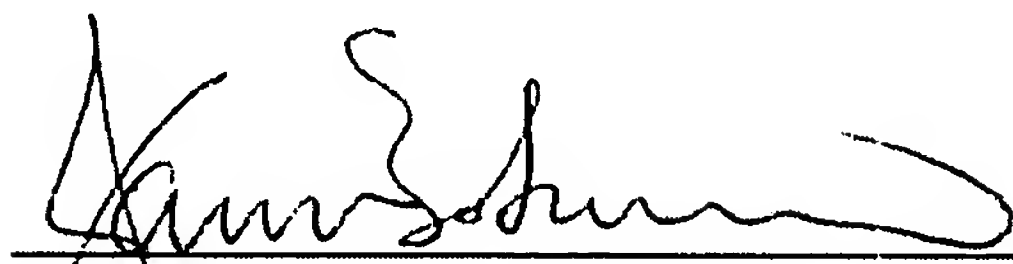
The fee for a two-month extension for filing this reply is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply all charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 05918-336US1.

Applicant : William H. Shepard et al
Serial No. : 10/524,881
Filed : October 19, 2005
Page : 13 of 13

Attorney's Docket No.: 05918-336US1 / VGCP No.
5051

Respectfully submitted,

Date: September 4, 2007



James W. Babineau
Reg. No. 42,276

Fish & Richardson P.C.
One Congress Plaza, Suite 810
111 Congress Avenue
Austin, TX 78701
Telephone: (512) 472-5070
Facsimile: (512) 320-8935

11018614.doc